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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of;

Ophira and Dov Aharanson

Serial No. 08/729,341

Art Unit: 2674

Filed: 10/16/1996

Examiner: Regina Liang

For: METHOD OF AND STATION FOR INTEGRATED TYPED DATA AND  
OPTICALLY SCANNED DATA CAPTURE FOR COMPUTER  
INTERFACING AND THE LIKE

APPEAL BRIEF

This is an appeal, dated August 10, 2007, from the decision of the Primary Examiner of February 22, 2007, finally rejecting claims 1-11, 20-42, 52 and 58 of the above-identified application.

(i) Real party in interest

Ophira R. Aharanson and Dov Aharanson are the real parties of interest herein.

(ii) Related appeals and interferences

None

(iii) Status of claims

[Parent application issued on keyboard integrative inventive features as U.S. Patents Nos. 5,447,238 and 5,623,295].

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Claims 1-11, and 20-42, (copied from Cotte U.S. Patent No. 5,499,108 for purposes of interference proceedings) and claims 57 and 58 modeled after Cotte claims 1 and 2, are all pending on appeal of this continued examination application (37CFR 1.114).

Each of these claims 1-11, 20-42, 57 and 58 has been finally and solely rejected under 35 USC § 112, first paragraph, as “containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) , at the time the application was filed, had possession of the claimed invention” .

(iv) Status of amendments

No amendment was filed subsequent to the granting of the continued examination request and this final rejection thereof.

(v) Summary of claimed subject matter

In summary, this invention, as presented in applicants’ specification, has as its basic concept, the initiation of document scanning for providing scanned images to a host computer and protocol communication therewith by the mere “inserting (of) a document into the scanner feeding slot 14 (master mode)”, rather than by the conventional starting “of the scanning process...by scan command from the host computer (slave mode)”.

Independent claims 1 and 32, selected by the Examiner as exemplary, recite, as the Examiner correctly states, that this placement of the document into the scanner “alone is sufficient to initiate said drawing” of the document through

the scanner so as to be scanned. The claims further recite, as also stated by the Examiner, that this placement initiates the host computer display of “user-selectable options for processing said image data” – and which the Cotte patent concedes are the inherent “typical pop-up windows of user menu options” of all host computers of the time (col. 18, l. 51), including applicants’.

The following is an identification of the means plus function in each independent claim by reference in brackets to the specification and drawings:

1. A system comprising a document-driven scanning input device (H3) communicating with a computer (H1), said input device comprising scanning means for generating image data representing the image of a document (14), and means, responsive to placement of a document by a user, for drawing the document into scanning relationship (3, 4, 6A, etc.) with said scanning means so that said scanning means generates image data (5, 20) representing the image of said document, wherein said placement alone is sufficient to initiate said drawing (p. 18, l. 8-18; p. 24, l. 1, on), and said computer (H1) comprising means for displaying (H2), in response to said placement, a plurality of user-selectable options for processing said image data.
2. A system according to claim 1 wherein said computer further comprises means for displaying a visual representation of said image data generated in response to said placement.

3. A system according to claim 2 wherein said means for displaying displays said visual representation immediately upon generating of image data by said scanning means.
4. A system according to claim 1 wherein said computer further comprises means for establishing which option has been selected by the user and for invoking a process corresponding to the option selected by the user and for invoking a process corresponding to the option selected by the user for processing said image data.
5. A system according to claim 1 wherein said computer further comprises means for displaying a visual representation of said image data generated in response to said placement, and means for establishing which option has been selected by the user and for invoking a process corresponding to the option selected by the user for processing said image data.
6. A system according to claim 5 wherein said means for displaying displays said visual representation immediately upon generation of image data by said scanning means.
7. A system according to any one of claims 1-6 wherein said means for drawing the document into scanning relationship with said scanning means responds to the insertion of the document into said input device by the user.
8. A system according to claim 1 wherein said means for drawing the document into scanning relationship with said scanning means sends an interrupt to said computer in response to said placement and wherein said

computer displays said plurality of options in response to receiving said interrupt.

9. A system according to claim 1 wherein said means for displaying a plurality of options periodically polls said input device to determine whether a document has been placed by a user.

10. A system according to claim 1 wherein said computer further comprises means for storing said image data.

11. A system according to claim 1 wherein said input device further comprises means for storing said image data.

20. A document-driven system comprising a scanning input device (H3) communicating with a computer (H1), said input device comprising scanning means for generating image data representing the image of a document (14), and means for sensing placement (2, 4, etc.) of a document by a user and said computer comprising means for displaying (H2) in response to said placement, a plurality of user-selectable options for processing said image data, wherein said placement alone is sufficient to initiate display of said options (P. 18; l. 17, 18).

21. A system according to claim 20 wherein said computer further comprises means for establishing which option has been selected by the user and for invoking a process corresponding to the option selected by the user.

22. A system according to claim 20 wherein said means for sensing responds to insertion of the document into said input device by the user.

23. A system according to claim 20 wherein said means for sensing said placement sends an interrupt to said computer in response to said placement and wherein said computer displays said plurality of options in response to receiving said interrupt.

24. A system according to claim 20 wherein said means for displaying a plurality of options periodically polls said input device to determine whether a document has been placed by a user.

25. A system according to any one of claims 20 through 24, wherein said input device further comprises means for drawing the document into scanning relationship with said scanning means in response to said placement-.

26. A document-driven system comprising a document scanner, said scanner including a document sensor (2, 4, etc.), and a computer (H1), said computer communicating with said document scanner, (3, 4, 5, etc.) said computer displaying, in response to the scanner sensing a document, a plurality of user-selectable options for processing image data from said scanner, wherein said placement alone is sufficient to initiate display of said options p18, l. 14-18; p. 24, l1, on).

27. A system according to claim 26 wherein said computer establishes which option has been selected by the user and invokes a process corresponding to the option selected by the user.

28. A system according to claim 26 wherein said sensor responds to insertion of the document into said scanner.

29. A system according to claim 26 wherein said scanner sends an interrupt to said computer when the scanner senses a document and said computer displays said plurality of options in response to receiving said interrupt.

30. A system according to claim 26 wherein said computer periodically polls the scanner to determine whether the scanner has sensed a document-.

31. A system according to any one of claims 26 through 30, wherein said scanner scans the document in response to sensing the document-.

32. A document-driven system comprising a document scanner (3, 4, 5, etc.), said scanner, in response to placement of a document by a user, scanning the document and generating image data representing the image of the document, wherein said placement alone is sufficient to initiate said scanning and generating, and a computer (H1), said computer communicating with said document scanner, said computer displaying (H2), in response to said placement, a plurality of user-selectable options for processing said image data (p. 18).

33. A system according to claim 33 wherein said computer displays said visual representation of said image data generated in response to said placement.

34. A system according to claim 33 wherein said computer displays said visual representation immediately upon generation of image data by said scanner.

35. A system according to claim 32 wherein said computer establishes which option has been selected by the user and processes said image data in accordance with the option selected by the user.
36. A system according to claim 32 wherein said computer displays a visual representation of said image data generated in response to said placement, establishes which option has been selected by the user, and processes said image data in accordance with the option selected by the user.
37. A system according to claim 36 wherein said computer displays said visual representation immediately upon generation of image data by said scanner.
38. A system according to any one of claims 32-37 wherein said scanner scans in response to the insertion of the document into the scanner by the user.
39. A system according to claim 32 wherein said scanner sends an interrupt to said computer in response to said placement and wherein said computer displays said plurality of options in response to receiving said interrupt.
40. A system according to claim 32 wherein said computer periodically polls said scanner to determine whether a document has been placed by a user.
41. A system according to claim 32 wherein said computer also stores said image data.
42. A system according to claim 32 wherein said scanner includes storage for said image data.

57. A system comprising a document-driven scanning input device (H3) communicating with a computer (H1), said input device comprising scanning means for generating image data representing the image of a document (14), and means, responsive to simply inserting a document by a user into the scanning means, for drawing the document into scanning relationship (3, 4, 6A, etc.) with said scanning means so that said scanning means generates image data (5, 20) representing the image of said document, wherein said inserting is sufficient to initiate said drawing (p. 18, l.8-18; p. 24, l.1, on), and said computer comprising means for displaying (H2) the scanned image data, and means operable in response to said inserting of the document for initiating communications protocol with the computer for a plurality of user-selectable options for processing said image data.

58. The system according to claim 57 wherein, in initiating said communications protocol, said computer further comprises means for receiving the scanned data for displaying a visual representation of said image data generated in response to said scanning.

(vi) Grounds of rejection to be reviewed on appeal

The sole ground of rejection, as earlier mentioned, is that all the claims 1-11, 20-42, 57 and 58 lack support in the specification (35 USC § 112, first paragraph); specifically, that applicants' disclosure does not support the limitation of Cotte et al claims 1 and 32 that

"said placement alone is sufficient to initiate said drawing, nor means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data."

Claims 1 and 32 and their dependent claims 2-11 and 33-42 and similar claims 20-31 and 57-58 have accordingly been rejected under 35 U.S.C. 112, first paragraph, as "containing subject matter not described in the specification."

In this rejection, the Examiner has ignored the expert testimony provided in the expert Declaration of Ralph Rodriguez filed herein demonstrating that the specification actually contains such full disclosure, and has failed to provide in rebuttal any authoritative references, citations or other evidence that a single Rodriguez fact therein stated under oath, is incorrect.

Finally, the Examiner has also completely failed to justify his thwarting of the established "full faith and credit" rules of practice governing the authority and behavior of the examining corps.

This has necessitated the filing of this continuation request and the painful further delay involved in order to provide a complete record suitable for the filing of this appeal.

#### (vii) Argument

It will now be shown that the claims are indeed fully supported by the original disclosure and should have been allowed to applicants.

Exemplary independent claims 1 and 32 (earlier copied from Cotte et al U.S. Patent No. 5,499,108 for purposes of interference) uses the specific words "in response to" placement of the document into the scanner.

The new and present Examiner in this case has interpreted these claim limitations "in response to" as meaning something different from the description of operation in applicants' specification --therefore rejecting the claims (and all others depending therefrom) under 35 U.S.C. 112, first paragraph.

The Examiner bases the rejection specifically on an inability to find the exact words "in response to", in applicants' specification.

Applicants would point out that these precise words "in response to" and "responsive to" as claimed, are not found in the Cotte specification. They appear to have originated in the Cotte claims.

If, however, the substance of what is actually disclosed in the Cotte patent does indeed respond to this specific claim word limitation, then it applies in exactly the same way to, the applicants' disclosure.

Similarly, if the conventional dictionary definition applies to these words, moreover, they identically read upon the disclosures of the Cotte patent and the applicants' disclosure (i.e. "react to"; "act in answer to something"--p.711, Roget's 21<sup>st</sup> Thesaurus, for example).

It is in order, therefore, to review what the actual operation of the Cotte patent (where the claims originated) actually involves, because that, it is submitted, is what these words must be interpreted as meaning.

## The Cotte et al Patent Structure Compared With Applicants' Structure

The following demonstrates that Cotte et al and applicants have made the same invention and for the same purpose.

### Cotte et al

- (1) In summarizing the operation of their patent, Cotte et al use a "paper *input device*" that "senses the insertion of a document to be scanned (and) initiates a host computer process...scans the images and text on the paper...while sending the scanned data to the host for further electronic processing such as *display*, transmission, *storage* or modification" (col. 2, lines 41 on).
- (2) The "user can put the document in the paper input device and the input device software will automatically scan the document" (col. 16, l. 7).
- (3) The broad novelty of "this new technology is a paper input device using scanning technology which controls the host computer rather than *the other way around*, the latter being what is taught in the *prior art*" (col. 2, l. 50).
- (4) Among the important applications are for "FAX" (col. 13, l. 28) and "photocopy" function (col. 19, l. 39). An objective is to aid untrained people to operate: "simplifies the life of the user...and is decoupled

from the need to *know how* to invoke the appropriate software" (col. 14, l. 40).

### Applicants

- (1) Applicants also use the "scanners" ...as *input devices*, (col. 7, l. 49), [referring more conveniently to applicants' parent patent 5,623,295 which has the identical disclosure of the application], wherein "the user inserts the paper into the paper feeding slot. A sensor detects the document, scans it and sends the data back to the computer" (col. 7, l. 54). In the "master mode", the scanner sensor "*automatically* starts scanning, initiates communications protocol with the host computer and the host receives the scanned data" (col. 6, l. 30).
- (2) "The user starts the scanning process...*simply by* inserting a document into the scanner feeding slot 14 (master mode)", (col. 6, l. 17).
- (3) In the "master mode", the "keyboard-scanner is the master device and the computer is used (transparently to the user) as a slave output device" (col. 8, l. 12), instead of "the *regular* way a scanner keyboard and other auxiliary I/O devices work with the computer [i.e. prior art].
- (4) Among the important "predefined functions" is "for *fax* machine operation" (col. 8, l. 25, on) and "*copying* machines" (col. 6, l. 51; col. 8, l. 35). "The master mode of operation, moreover, enables *untrained*

*people* easily to operate the computer as familiar "FAX or COPY machines." (col. 8, l. 40). This is done "transparently to the user" (col. 8, l. 12), "where a user is not familiar with computers" or *lacks* "know how to operate the computer and its software applications" (col. 7, l. 60).

### Cotte et al

The "paper input device...senses the insertion of a document to be scanned, *initiates a host computer process*..."There is then "the sending (of) the scanned data to the host for...*display*" or for "*storage*" (col. 2, l. 47) in accordance with the "computer process."

### Applicants

"The user inserts a document into the scanner input slot...and starts a communication protocol with the host computer."

There is then "communication with the host computer" of "the document scanned data" (col. 6, l. 7). This is in accordance with this "protocol", wherein "the host receives the scanned data...where it is *stored* for application to retrieve it" (col. 6, l. 33), or "may also use the computer to *display*" the scanned data (col. 8, l. 32). See, also, col. 8, l. 30, "the computer is used as a slave output device for *display communication*".

Corroborating the above as to what applicants' description means to one skilled in the art, applicants refer to the testimony of the earlier submitted

Declaration of Ralph Rodriguez of January 23, 2004:

"10. Treating with the first alleged lack of description (i.e. that the specification does not teach that "the placement alone is sufficient to initiate said drawing" of the document through the scanner), the Examiner, with respect, is absolutely in error!

This is *exactly* what one skilled in this art understands to be described in column 6, lines 16-19;

"The user starts the scanning process... simply by inserting a document into the scanner feeding slot 14 (master mode)."

More than just initiating the feeding and scanning of the document through the scanner, this act of "inserting the document into the scanner," also automatically "initiates communications protocol with the host computer" (column 6, line 31,), which is then "used as a slave output device for display communication and printing" (column 8, lines 2-5 -- incidentally describing *two* distinct user-selectable options)."

#### Cotte et al

To effectuate "*display*" of the scanned image data, Cotte et al, in several embodiments, sends the scanned data to be "buffered in RAM memory...until such time as data path...is not busy"; and then such is retrieved from such storage and sent "to the host computer...for further processing or to the FAX modem" (col. 9, l. 1-10).

As again explained at col. 10, line 1, in Cotte et al, after "the document is scanned", the "data is *buffered* either before or after being compressed...for *later transmission* to the host computer or the FAX modem."

## Applicants

Applicants describe, also, that "*simply by inserting* a document into the scanner feeding slot" (col. 6, l. 17), the "scanner automatically starts scanning, *initiates* communications protocol with the host computer and the host receives the scanned data...where it is *stored* for application to retrieve it" (col. 8, l. 32), as for "use (of) the computer display to *display* " (col. 8, l. 33).

Whereas Cotte et al, as above quoted, may first store the scanned image data in a "buffer", applicants may first store in a " 'spool' directory" (col. 6, l. 33).

This brings us to the last "means" of claim 1. Claim 1 (unlike claim 2), however, does not address or require the displaying of the scanned image data itself.

Claim 1 recites only the displaying of

"a plurality of user-selectable options for processing said image data"; but with the requirement that such displaying be "*in response to said placement*"--again, however, with no apparent use or definition of that term in the specification.

## Cotte et al Display of Options

In Fig. 17 and in column 10, starting at line 44, however, Cotte et al do define what they mean by the claimed phrase "user-selectable options for processing said image data". These are "menu options...such as 'FAX this image'...'send this image...for printing", etc.

### Applicants Display the Same Options

These very *same options* for processing the scanned image data, among others, are also taught in applicants' specification and drawings: "SEND FAX" (col. 8. l. 25); "prints it on the printer, FIGS. 7C, 7D, 7G" (col. 8. l. 40). Applicants describe the "options" as "preferred functions" (col. 8, l. 25).

Applicants further positively teach that such options for processing the scanned image data may also be *displayed*:

"may also use the computer display to display...transmitted fax status information and *operation instructions*, Figs. 7C, 7D, 7E, 7F," (col. 8, l. 33).

[See, for example, in "MASTER OPERATION MODE of Fig. 7C-7E of the drawings; "HOST 'DISPLAY STATUS', 'FAX FUNCTION', 'COPY FUNCTION', etc)].

That the "communications protocol" with the computer was initiated "*solely*" by the placement of the document in applicants' scanner has been demonstrated above.

Cotte et al uses the words "*commands*" (col. 14, l. 31; col. 15, l. 28 and 61, on; col. 18. l. 66; col. 21, l. 22) and "*protocol transmission*" (col. 15, l. 1; col. 17, l. 21) to describe the well-known protocol that is also identically described by applicants and in the very same words: "*command*" (col. 6, l. 17, 23) and "*communications protocol*" (col. 6, l. 31; col. 8, l. 21, 31, 37). Neither Cotte et al nor applicants go into detail on these "protocols" since they were so well-known at the time and inherent in the pertinent host computers. (Rodriguez Declaration).

The only remaining limitations of claim 1 is that such "protocols" for enabling host computer display of options must be initiated "in response to said placement". Both Cotte et al and applicants disclose doing this initiation in precisely the same manner "in response to" the insertion of the document, as earlier discussed:

#### Cotte et al

"senses the insertion of a document to be scanned, initiates a host computer process"...by insertion of the paper...scans the images and text on the paper...while sending the scanned data to the host for further electronic processing such as display...storage" (col. 2, l. 42, on).

#### Applicants

"the user inserts the paper into the paper feeding slot. A sensor detects the document" (col. 7, l. 54) and "automatically starts scanning, initiates communications protocol with the host computer and the host receives the scanned data" (col. 6, l. 30).

"simply inserting a document into the scanner feeding slot 14 (master mode)", (col. 6, l. 17).

#### Summary

The above is believed unambiguously to show the substantial identity of the Cotte et al disclosure and operation and that of applicants. Claim 1 (and the other claims) if read to mean and describe what Cotte et al discloses, must also be read in precisely the same way on applicants' disclosure.

In further support of the above, the expert testimony provided in said Declaration of Ralph Rodriguez states

"11...As one skilled in this art, reading the application and including the reference to "menu" in column 7, line 52 and knowing that, as before stated, in the port connection of all scanners to "IBM PC" computers in that era (column 6, lines 7-10), protocol universally involved initially and automatically displaying the menu on the computer screen upon hook-up to the scanner, I must strongly state that the specification thus positively provides such a teaching, and that such display of the menu on the screen was also inherent for all scanner-computer connection protocol." (Underlining added)."

"The application teaches, moreover, that precisely this same menu display protocol was then the conventional operation with all scanners, also (column 7, line 51, on; also column 4, lines 20-27)."

The Rodriguez Declaration continues:

"This only leaves the matter of whether this "displaying" is of "a plurality of user-selectable options"....

"With the insertion or placement of the document in the scanner in the "Master Mode", (col. 8, line 3, on) initiating the display communication protocol, including "SEND TO HOST ' DISPLAY STATUS' COMMAND" (Fig. 7C, before discussed), this causes the displaying of the universal protocol options menu, always provided in the 1992 era by scanner-computer interfacing."

"This, to one skilled in the art including me, is also explained in paragraph 9 above, and clearly means the display by the computer monitor of "a plurality of user-selectable options for processing said image data "of claim 1 -- and it certainly is taught in the application, as initiated in the application by placement alone of the document into the scanner." [Underling added]

18. The objectives and basic implementation of applicants and of Cotte et al are the same; and claim 1, above-discussed, certainly

applies equally to their respective disclosures and in the same way."

The Examiner's Invitation To Provide Evidence  
of Well-Known Inherent Features in the Prior Art

Though applicants original disclosure clearly teaches

"means for displaying, in response to said placement, a plurality of user-solicitable options for processing said image",

the Examiner invited the submission of evidence as to what "features are well-known in the art."

Even had applicants not specifically taught the displaying of a plurality of user-selectable options (which the Examiner on page 5, lines 7 and 8, of his previous action appears correctly to concede that they did describe, as above shown), the feature of automatic display in personal and other host computers of "user-selectable options" were indeed well-known and inherent in all such computers at the time of both the Cotte et al and applicants' applications.

The patent to Cotte et al so admits:

"A *typical* pop-up window of user menu options" (col. 15, l. 51).

"software *commonly found* on user's computers" (col. 11, l. 47)

"the details of the *prior art* image compression algorithms are incorporated by reference as if set out fully herein" (col. 14, l. 59).

"user...selections from a menu of options which automatically appears" (col. 15, l. 30).

Applicants' specification also so concedes:

"The electronic circuit board 12, 13...circuits, in *well-known* fashion, control all keyboard and scanner operations" (col. 5, l. 37).

"IBM PC" (col. 1, l. 47); with a personal computer...with a PC or any other host, using the office or external network..." (col. 6, l. 50).

"The user may choose to use a scanner for data input by picking scan operation from a menu... This is the *regular way* a scanner keyboard and other auxiliary I/O devices work with a computer" (col. 7, l. 56).

"the operations *found on any* fax or copy machine" (col. 8, l. 26).

In further support of the above, the expert testimony provided in said Declaration of Ralph Rodriguez states:

"The application teaches, moreover, that precisely this same menu display protocol was then the conventional operation with all scanners, also (column 7, line 51, on; also column 4, lines 20-27)."

Earlier, Mr. Rodriguez explained that:

"8. Long before the filing of the above application, hundreds of thousands of scanners interfaced or communicated with host computers all over the world, -- and for...well-known protocols for... a menu of user-selectable options or functions indicated on the display. Everyone skilled in this art knows (and certainly knew at the time of the filing of the above application) that this is how scanners in 1992 *always* communicated with computer displays -- every one of the scanner modules identified at the top of column 2 (lines 1-6), and every one of their protocols with the "IBM PC" host computer of the era (column 1, line 43)."

What was not known, however, before the applicants' invention and the Cotte et al disclosure, was the initiation of such display of user-selectable options "in response to said placement" of the document in the scanner.

The Examiner appears, however, now to agree that there was no lack of disclosure in applicants' application of

"just simply displaying a plurality of user-selectable options" (page 5, lines 7 and 8 of Examiner's previous action).

The Examiner contends, rather, that the applicants did not disclose such displaying

"in response to said placement"

of the document into the scanner input device.

This has earlier been shown, however, to be in error as above quoted. As summarized by Mr. Rodriguez in his Declaration:

"19. In summary, therefore, it is the placement of the document into the scanner slot of applicants' scanner that alone initiates the scanning, and alone starts the communication protocol, including display for user-selection of options.

This is also made extremely clear in connection with the description of the options of "fax/copy":

"When operating in "master mode" ...when the user inserts a document into the document feeding slot 14, a sensor 4, 4a, senses the document and converts the operation of the device...where the keyboard-scanner is the master device and the computer is used (transparently to the user) as a slave output."  
(Column 8, line 5, on).

"The user inserts a document into the scanner input slot 14. The inserted document moves the mechanical arm 4A of the document sensor 4. The sensor sets flag "MASTER" ON...and starts a communication protocol with the host computer...It may also use the computer display to display...status information, and operation instructions, FIGS 7C, 7D, 7E, 7F." (Column 8, line 33, on).

And earlier, for just document scanning and the options of image display

and storage:

“ The user starts the scanning process...simply by inserting a document into the scanner feeding slot 14 (master mode)...the scanner automatically starts scanning, initiates communications protocol with the host computer and the host receives the scanned data into a 'spool' directory where it is stored for application to retrieve it...” (Col. 6).

The running display of scanned image data and storage are, of course, and were in 1992, the standard computer-scanner protocol, inherent in all such systems.

To one skilled in the art, including me, this unambiguously teaches the specific limitations of claim 1:

“wherein said placement alone is sufficient to initiate said drawing, and said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data”.

Applicants' disclosure clearly meets the terms of the claims, which are accordingly allowable to them

In order to complete the record herein of prior art known features, moreover, as to the meaning in the era of applicants' application of the phrase "the host receives the scanned data into a 'spool' directory" (col. 6, l. 33), applicants also submitted the Declaration of Dov Aharanson.

### The Further Impropriety Of This Belated § 112 Rejection

If the previous Examiner had held the present Examiner's § 112 views as to lack of disclosure there would have been no need to have suspended ex parte prosecution until determination of the re-examination of the Cotte et al patent

from which applicants copied the present claims for purpose of interference--only to reject the claims as not supported by the disclosure.

Clearly, in continuing all these years and in entering the suspension, the view of the previous Examiner was that an interference was appropriate.

Never, in response to applicants' status requests, or oral and written communications with the first Examiner, over a *six-year period*, did the first Examiner ever raise any issue, 112 or otherwise, of the adequacy of applicants' specification disclosure to support a single one of these claims--only the continuing promise of the declaration of an interference "soon".

As earlier pointed out--and the present Examiner has *not* answered this--MPEP- Sec. 2307.04. --specifically restricts the use of such a suspension to cases "*otherwise in condition for allowance*".

The first Examiner thus clearly issued the suspension under this understanding of allowability to applicants; and applicants had no objection, being also anxious to determine the validity of the claims under re-examination.

As also earlier pointed out--and again the present Examiner has *not* answered this--MPEP- Sec. 2307.04. --specifically restricts the use of such a suspension to cases "*otherwise in condition for allowance*".

As also earlier pointed out--and again the present Examiner has *not* answered this--the MPEP instructs the Examiner to continue the prosecution "as far as possible", being specifically *mandated* by MPEP Sec. 707.07/g to "*reject each claim on all valid grounds available*".

The first Examiner had no such grounds (certainly not § 112) and never asserted any.


As also earlier pointed out--and again the present Examiner has *not* answered this--the MPEP Sec. 704 --requires "*full faith and credit...be given to...the action of a previous examiner...(and) an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner...*"

Over-ruling of this improper and greatly belated §112 rejection, and the prompt declaration of an interference are therefore believed to be in order--particularly, in light of there technical incorrectness of the new §112 rejection, as shown.

Any costs required by this filing, of the appeal brief, including for any and all required brief time extensions, petition for which is hereby made, may be charged to account No. 18-1425 of the undersigned counsel.

Respectfully submitted,

RINES AND RINES

By 

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603-228-0121

(viii) Claim Appendix

1. A system comprising a document-driven scanning input device communicating with a computer, said input device comprising scanning means for generating image data representing the image of a document, and means, responsive to placement of a document by a user, for drawing the document into scanning relationship with said scanning means so that said scanning means generates image data representing the image of said document, wherein said placement alone is sufficient to initiate said drawing, and said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data.
2. A system according to claim 1 wherein said computer further comprises means for displaying a visual representation of said image data generated in response to said placement.
3. A system according to claim 2 wherein said means for displaying displays said visual representation immediately upon generating of image data by said scanning means.
4. A system according to claim 1 wherein said computer further comprises means for establishing which option has been selected by the user and for invoking a process corresponding to the option selected by the user and for invoking a process corresponding to the option selected by the user for processing said image data.

5. A system according to claim 1 wherein said computer further comprises means for displaying a visual representation of said image data generated in response to said placement, and means for establishing which option has been selected by the user and for invoking a process corresponding to the option selected by the user for processing said image data.
6. A system according to claim 5 wherein said means for displaying displays said visual representation immediately upon generation of image data by said scanning means.
7. A system according to any one of claims 1-6 wherein said means for drawing the document into scanning relationship with said scanning means responds to the insertion of the document into said input device by the user.
8. A system according to claim 1 wherein said means for drawing the document into scanning relationship with said scanning means sends an interrupt to said computer in response to said placement and wherein said computer displays said plurality of options in response to receiving said interrupt.
9. A system according to claim 1 wherein said means for displaying a plurality of options periodically polls said input device to determine whether a document has been placed by a user.
10. A system according to claim 1 wherein said computer further comprises means for storing said image data.

11. A system according to claim 1 wherein said input device further comprises means for storing said image data.
20. A document-driven system comprising a scanning input device communicating with a computer, said input device comprising scanning means for generating image data representing the image of a document, and means for sensing placement of a document by a user and said computer comprising means for displaying in response to said placement, a plurality of user-selectable options for processing said image data, wherein said placement alone is sufficient to initiate display of said options.
21. A system according to claim 20 wherein said computer further comprises means for establishing which option has been selected by the user and for invoking a process corresponding to the option selected by the user.
22. A system according to claim 20 wherein said means for sensing responds to insertion of the document into said input device by the user.
23. A system according to claim 20 wherein said means for sensing said placement sends an interrupt to said computer in response to said placement and wherein said computer displays said plurality of options in response to receiving said interrupt.
24. A system according to claim 20 wherein said means for displaying a plurality of options periodically polls said input device to determine whether a document has been placed by a user.

25. A system according to any one of claims 20 through 24, wherein said input device further comprises means for drawing the document into scanning relationship with said scanning means in response to said placement-.
26. A document-driven system comprising a document scanner, said scanner including a document sensor, and a computer, said computer communicating with said document scanner, said computer displaying, in response to the scanner sensing a document, a plurality of user-selectable options for processing image data from said scanner, wherein said placement alone is sufficient to initiate display of said options.
27. A system according to claim 26 wherein said computer establishes which option has been selected by the user and invokes a process corresponding to the option selected by the user.
28. A system according to claim 26 wherein said sensor responds to insertion of the document into said scanner.
29. A system according to claim 26 wherein said scanner sends an interrupt to said computer when the scanner senses a document and said computer displays said plurality of options in response to receiving said interrupt.
30. A system according to claim 26 wherein said computer periodically polls the scanner to determine whether the scanner has sensed a document-.
31. A system according to any one of claims 26 through 30, wherein said scanner scans the document in response to sensing the document-.

32. A document-driven system comprising a document scanner, said scanner, in response to placement of a document by a user, scanning the document and generating image data representing the image of the document, wherein said placement alone is sufficient to initiate said scanning and generating, and a computer, said computer communicating with said document scanner, said computer displaying, in response to said placement, a plurality of user-selectable options for processing said image data.

33. A system according to claim 33 wherein said computer displays said visual representation of said image data generated in response to said placement.

34. A system according to claim 33 wherein said computer displays said visual representation immediately upon generation of image data by said scanner.

35. A system according to claim 32 wherein said computer establishes which option has been selected by the user and processes said image data in accordance with the option selected by the user.

36. A system according to claim 32 wherein said computer displays a visual representation of said image data generated in response to said placement, establishes which option has been selected by the user, and processes said image data in accordance with the option selected by the user.

37. A system according to claim 36 wherein said computer displays said visual representation immediately upon generation of image data by said scanner.

38. A system according to any one of claims 32-37 wherein said scanner scans in response to the insertion of the document into the scanner by the user.

39. A system according to claim 32 wherein said scanner sends an interrupt to said computer in response to said placement and wherein said computer displays said plurality of options in response to receiving said interrupt.

40. A system according to claim 32 wherein said computer periodically polls said scanner to determine whether a document has been placed by a user.

41. A system according to claim 32 wherein said computer also stores said image data.

42. A system according to claim 32 wherein said scanner includes storage for said image data.

57. A system comprising a document-driven scanning input device communicating with a computer, said input device comprising scanning means for generating image data representing the image of a document, and means, responsive to simply inserting a document by a user into the scanning means, for drawing the document into scanning relationship with said scanning means so that said scanning means generates image data representing the image of said document, wherein said inserting is sufficient to initiate said drawing, and said computer comprising means for displaying the scanned image data, and means operable in response to said inserting of the document for initiating communications protocol with the computer for a plurality of user-selectable options for processing said image data.

58. The system according to claim 57 wherein, in initiating said communications protocol, said computer further comprises means for receiving the scanned data for displaying a visual representation of said image data generated in response to said scanning.

(ix) Evidence Appendix

None

(x) Related Proceedings Appendix

None